

### **REMARKS**

In response to the Office Action dated December 16, 2005, Applicant respectfully requests reconsideration based on the above claim amendments and the following remarks. Applicant respectfully submits that the claims as presented are in condition for allowance.

Claims 1-20 remain pending in the present application. Claims 4-10 and 14-18 have been previously withdrawn. Claims 2, 12, and 20 have been canceled without prejudice, waiver, or disclaimer of the subject matter recited therein. Claims 1, 11, and 19 have been amended, leaving Claims 1, 3, 11, 13, and 19 for consideration upon entry of the present amendment. The specification was amended. No new matter has been introduced by these amendments.

### **IN THE DRAWINGS**

The drawings were objected to under 37 CFR § 1.83(a) as not showing every feature of the subject matter specified in the claims. In particular, the Office on page 2 of the Office Action, stated the “attachment mechanism” recited in claim 2 must be shown or the feature(s) canceled from the claim(s).

Applicant has amended Claims 1, 11, and 19, which do not recite “attachment mechanism” as a feature. The amended claims recite in part “the spiral groove provides one or more mechanisms for attachment.” Support can be found in the original disclosure at least in the Specification in paragraph [0011]. Thereby, rendering moot the objection of the drawings.

## IN THE SPECIFICATION

### *Claim Rejections Under 35 U.S.C. § 112, First Paragraph*

Claims 1-3, 11-13, and 19-20 stand rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the enablement requirement. On page 3 of the Office Action, the Office stated the claims contain subject matter which was not described in the Specification in such a way as to enable one skilled in the art to make and/or use the invention.

Applicant has amended the Specification to include the features of the claims. In particular, two paragraphs describe how to make and/or use the claimed subject matter (see, Amendments to the Specification, page 2).

Support for the amended paragraphs can be found from the original disclosure. Therefore, the above revisions to the specification do not raise the issue of new matter. For example, support can be found in the Specification at least at paragraphs [0002], [0004], [0005], [0011], [0012], [0023], [0025], [0027], and Figures 8 and 12. Applicant respectfully requests that the above § 112, 1<sup>st</sup> paragraph, rejections be withdrawn.

## IN THE CLAIMS

### *Claim Rejections Under 35 U.S.C. § 102(b)*

Claims 1-3 and 19-20 stand rejected under 35 U.S.C. § 102(b), as allegedly anticipated by U.S. Patent No. 2,559,160 to Jacob et al. (hereinafter "Jacob"). Applicant respectfully traverses this rejection.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference (see, MPEP § 2131).

While not conceding the propriety of the stated rejection, or conceding that the cited art provides the teaching for which it is cited, and only to advance prosecution of this application, the Applicant has amended independent Claims 1 and 19 to further clarify features of Applicant's claimed subject matter. Support may be found from the Specification at least at paragraphs [0017] and [0018] and at least at Figures 8 and 12.

Independent Claim 1, which is directed to a fish tape, has been amended to recite in part:

*"a longitudinal portion comprising a circular outer diameter, wherein the circular outer diameter ranges from about 0.1875 inches to about 0.375 inches; defining a substantially cylindrical shape along the longitudinal portion of the fish tape, wherein the substantially cylindrical shape comprises a plurality of spiral grooves defined along the circular outer diameter and extending along the longitudinal portion; and*

*an end portion comprising a spiral groove extending from the end portion partially along the longitudinal portion, wherein the spiral groove provides one or more mechanisms for attachment"*

Independent Claim 19, which is directed to a fish tape, has been amended to recite in part:

*"a longitudinal portion comprising ~~a~~ a circular outer diameter, defining a substantially cylindrical shape along ~~a~~ the longitudinal portion of the fish tape, wherein the substantially cylindrical shape comprises a plurality of spiral grooves defined along the circular outer diameter and extending along the longitudinal portion; and*

*an end portion comprising a spiral groove extending from the end portion partially along the longitudinal portion, wherein the spiral groove provides one or more mechanisms for attachment”*

Applicant asserts Jacob fails to anticipate independent Claims 1 and 19 because Jacob does not disclose the recited features of the claimed subject matter. Jacob discloses a conventional flat steel “fish-tape” (see Col. 1, lines 9-10). In Jacob, the flexible element or tape is a tightly wound continuous helical coil **spring** which forms the outer portion (see, Col. 2, lines 52-53). The ends in Jacob have solid head portions each having an ovular transversely directed aperture and each having a rounded end (see, Col. 2, lines 43-44 and 51-54). Therefore, Jacob does not anticipate independent Claims 1 and 19 because it does not expressly or inherently disclose each and every element of these claims.

With respect to Claim 3, which depends directly or indirectly from independent Claim 1, it too is allowable for at least the reasons discussed above. Accordingly, the Applicant requests reconsideration and withdrawal of the § 102 rejections of Claims 1, 3, and 19.

*Claim Rejections Under 35 U.S.C. § 103(a)*

Claims 11-13 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Jacob in view of Prior Art Figure 1 of the instant case. Applicant respectfully traverses this rejection.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or

in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations (see, MPEP § 2142).

While not conceding the propriety of the stated rejection, or conceding that the cited art provides the teaching for which it is cited, and only to advance prosecution of this application, the Applicant has amended independent Claim 11 to further clarify features of Applicant's claimed subject matter. Support can be found from the Specification at least at paragraphs [0017] and [0018] and at least at Figures 8 and 12.

Independent Claim 11, which is directed to a fish tape device, has been amended to recite in part:

*“a circular outer diameter ranging from approximately 0.1875 inches to approximately 0.375 inches;*

*a longitudinal portion comprising the circular outer diameter defining a substantially cylindrical shape along the longitudinal portion of the fish tape, wherein the substantially cylindrical shape comprises a plurality of spiral grooves defined along the circular outer diameter and extending along the longitudinal portion; and*

*an end portion comprising a spiral groove extending from the end portion partially along the longitudinal portion, wherein the spiral groove provides one or more mechanisms for attachment”*

All of the § 103(a) rejections rely on Jacob. As explained above with respect to the rejection under 35 U.S.C. § 102(b), Applicant submits that Jacob does not disclose at least the above-quoted recited features of independent Claim 11. As Jacob does not disclose or teach or suggest all features recited in the claim, alone or in combination with

the other cited reference, Applicant submits that the claims are patentable over the pending obviousness rejections.

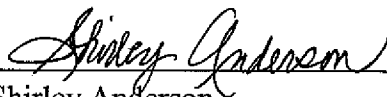
With respect to Claim 13, which depends directly or indirectly from independent Claim 11, it too is allowable for at least the reasons discussed above. Accordingly, the Applicant requests reconsideration and withdrawal of the § 103 rejections of Claims 11 and 13.

**Conclusion**

All pending claims are in condition for allowance. Applicant respectfully requests reconsideration and prompt issuance of the present application.

Respectfully Submitted,

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